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In re application of : **DECISION ON PETITION**
Kevin P. Parker et al. : **REGARDING REQUEST TO**
Application No. 10/775,039: **WITHDRAW CLAIM OBJECTIONS**
Filed: February 9, 2004 : **UNDER 37 CFR 1.181**

For: **STACK CONDITIONING APPARATUS
AND METHOD FOR USE IN BOOKBINDING**

This is in response to applicant's petition filed under 37 CFR 1.181 filed October 11, 2007 requesting withdrawal of final objection to the form of certain claims under 37 CFR 1.113 in the Office action mailed July 16, 2007.

The Petition is **GRANTED**.

Applicant alleges that the final objection of claims 27, 29, 45 and 59 mailed July 16, 2007 is improper and not in accordance with current Office practice.

MPEP 608.01(n) sets forth that although 37 CFR 1.75(c) requires the dependant claims to further limit a preceding claim, this rule does not apply to product-by-process claims.

A summary of the examiner's Office actions and of applicant's responses, with regard to the claims at issue, is as follows:

1. A first office action was mailed January 17, 2007 objecting to claims 27, 29, 45 and 59 under 37 CFR 1.75(c) as being in improper dependent form for failing to further limit the subject matter of a previous claim; and rejecting claims 27, 29, 45 and 59 under 35 USC 112 first paragraph and under 35 USC 102/103 as being anticipated by, or in the alternative, under 35 USC 103(a) as obvious over Ackley; and indicating claims 1-26, 28, 30-44 and 46-58 are allowable over the prior art of record.

2. Applicant's response filed June 15, 2007, argued the propriety of the claim objections, specifically quoting MPEP section 608.01(n), 112 rejections and prior art rejections.

3. A second, final office action was mailed July 16, 2007, repeating the objections and rejections of claims 27, 29, 45 and 59 in the nonfinal rejection mailed January 17, 2007 and further arguing the objection to the claims as being improperly dependent because they did not pass the infringement test.

4. Applicant filed a response August 2, 2007, arguing the propriety of the claim objections, specifically quoting MPEP section 608.01(n), 112 rejections and prior art rejections.

5. An Advisory Action was mailed August 27, 2007, stating the applicant had not overcome the prior art cited, nor amended the claims to satisfy the claim objections or the 112 first paragraph rejections.

6. On October 11, 2007 applicant filed a petition requesting withdrawal of the finality of the claim objections made in the final office action mailed July 17, 2007, notwithstanding the 112 first paragraph and prior art rejections.

After careful review of the above facts, the claim objections in the final office action were improper according to MPEP section 608.01(n) which excludes product by process claims from a claim objection under 37 CFR 1.75(c).

Hence applicant's petition to withdraw the claim objections in the Office action mailed July 16, 2007 is **GRANTED**.

Accordingly, the claim objection of the Office action mailed July 16, 2007, but not the action or the finality thereof, are withdrawn.

Inquiries related to this decision may be directed to Supervisory Patent Examiner Gene O. Crawford at (571) 272-6911.

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[GC: 12/17/07]

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